REMARKS/ARGUMENTS

The final office action of November 28, 2005 has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 35-53 remain in this application. Claims 1-34 were previously canceled.

Claims 35-53 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shibata et al., Dynamic Hypertext and Knowledge Agent Systems for Multimedia Information Networks, ACM 1993, pages 82-93, ("Shibata"), in view of U.S. patent no. 5,557,722 to DeRose et al. ("DeRose"). Applicants respectfully traverse this rejection.

In the last response, applicants asserted that Shibata does not teach or suggest interrogating the output device to determine a set of capabilities of the output device in response to a request for the document as recited in claim 35. In particular, applicants contested the assertion that the knowledge agent *must* interrogate the user's workstation to determine its capabilities and argued the mere fact that the media coordination layer in the knowledge agent converts the media formats of the original multimedia information units stored on the database servers to adjust to the user's workstation capabilities does not lead to the conclusion that the knowledge agent interrogated the user's workstation. Notably, Applicants pointed out, which the final action does not contest, that Shibata does not refer to such an interrogation in its description of the knowledge agent and media conversion layer. Then, applicants offered two reasonable alternative methodologies by which the knowledge agent could obtain the workstation capabilities; the user request could contain the information as to the workstation capabilities or the knowledge agent might already have the capabilities of the user's workstation stored locally. The final action refutes applicants' position, at pages 8 and 9, as follows:

> Since user access to the database is done from different multimedia workstations with different video and audio display capabilities, interrogating the capabilities of the output device must be performed for converting the media format to a format conforming to the capabilities of the user's workstation. Otherwise, the converted multimedia can not be disclosed properly in the request user's workstation. Further, the user request can not contain the information as to the workstation capabilities since conventionally, a user request for a document includes the query regarding a desired document only. Regarding the case that the knowledge agent already has the capabilities of the user workstation stored

locally, it appears impossible since the knowledge agent does not know ahead and does not need to store locally all of the capabilities of all of [the] different user workstations.

Applicants respectfully disagree. The notion that interrogating the capabilities of the output device *must* be performed or the multimedia can not be disclosed properly is simply not true. The final action is making an argument relying on the doctrine of inherency. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). Applicants have met the burden of rebutting the inherency argument based on Shibata by identifying alternative ways in which Shibata may obtain the capabilities of the device.

For example, the user request could contain information regarding the workstation capabilities. The rebuttal to this statement in the final action appears to be that "the user request can not contain the information as to the workstation capabilities since *conventionally*, a user request for a document includes the query regarding a desired document only." Applicants disagree and request the Examiner to establish that it would be so recognized by persons of ordinary skill that the only way to obtain the capabilities of the output device at the time of invention was by interrogating the output device. Even assuming, but not admitting, that the only way to obtain the capabilities of the output device was to interrogate the output device, that does not lead only to the conclusion that the interrogation occurred *in response to a request for the document* as called for in claim 1. Quite possibly, the output device could have registered with the system upon connection and could have been interrogated for its capabilities at that time rather than *in response to a request for the document*. This is an exemplary implementation of one of the scenarios applicants identified in the previous response. Specifically the knowledge agent already has the capabilities of the user's workstation stored locally. Refuting applicants' argument the action alleges that "it appears impossible since the knowledge agent does not know ahead and does not need to store locally all of the capabilities of all of [the] different user

workstations." The action's assertions are unsupported and seem to beg the question. Why could the knowledge agent not know the capabilities of the output device prior to a request for the document? Moreover, Shibata most certainly could store locally the capabilities of the user workstations following registration. There is no suggestion or teaching in Shibata of the particular methodology used to determine the capabilities of the output device or teaching away from any particular methodology or reasoning why one skilled in the art would not have considered each of the alternatives. Applicants have identified at least two alternative methodologies of how Shibata could carry out the determination, which have not been rebutted.

In view of the above, applicants submit that Shibata does not teach or suggest interrogating the output device to determine a set of capabilities of the output device in response to a request for the document as recited in claim 35. DeRose fails to remedy this defect. As such, the combination of Shibata and DeRose, even if proper, does not result in the claim 35 combination of features.

Independent claim 42 calls for, among other features, interrogating the output device to determine a set of capabilities of the output device in response to a request for the document; and generating a selected style sheet based upon the set of capabilities of the output device determined by interrogating the output device using the layout generator. Independent claim 48 as amended calls for, among other features, interrogating the output device to determine a set of capabilities of the output device in response to a request for the document; and based upon the set of capabilities of the output device determined by interrogating the output device, generating a style sheet. Thus, for substantially the same reasons as set forth with respect to claim 35, the combination of Shibata and DeRose, even if proper, does not result in the invention of claims 42 and 48.

Claims 36-41, 43-47 and 49-53, which ultimately depend from claims 35, 42 and 48, respectively are patentably distinct from the combination of Shibata and DeRose for the same reasons as their ultimate base claim and further in view of the additional advantageous features recited therein.
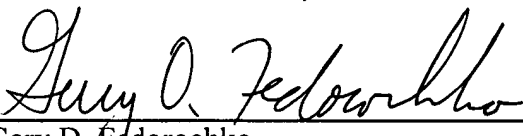
CONCLUSION

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: January 23, 2006   By: _____

Gary D. Fedorochko
Registration No. 35,509

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001

GDF:lab